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SEPT. 28, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re World Marketing Services, Inc.

Serial No. 75/036,568

Karen A. Jeffers of Jeffers & Associates for applicant.

Anil V. George, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney).

Before Rice, Seeherman, and Quinn, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An application has been filed by World Marketing
Services, Inc. to register the mark TRAVEL BARGAINS for
travel agency services, namely, making reservations and
bookings for transportation and arranging travel tours and
cruises.¹ Applicant seeks registration on the Principal
Register pursuant to the provisions of Section 2(f) of the

¹ Application Serial No. 75/036,568 filed December 28, 1998,
claiming first use and first use in commerce on May 12, 1991.

Trademark Act of 1946, 15 U.S.C. §1052(f), asserting that its mark has become distinctive of its services in commerce.²

Registration has been finally refused on two grounds. First, registration has been finally refused under Section 2(e)(1) of the Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's asserted mark TRAVEL BARGAINS, when used in connection with applicant's specified services, is merely descriptive of them; that the mark is, in fact, commonly used in the travel services field and is highly descriptive of such services; and that under the circumstances, the evidence submitted by applicant is insufficient to show that the mark has become distinctive of applicant's services in commerce.

Second, registration has been finally refused under Sections 1, 2, 3, and 45 of the Act, 15 U.S.C. §§1051, 1052, 1053, and 1127, on the ground that TRAVEL BARGAINS

² Applicant's application did not originally include a claim of distinctiveness under Section 2(f). In his first Office action, the Examining Attorney refused registration, inter alia, under Section 2(e)(1) of the Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, as used in connection with its services, is merely descriptive of them. Applicant in turn argued that its mark is suggestive, not merely descriptive, and claimed distinctiveness under Section 2(f) of the Act as an alternative basis for registration. However, in its brief on appeal, applicant made the following concession (at page 10): "For purposes of this appeal, Applicant concedes the Examiner's designation of the mark as 'merely descriptive' ..."

does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate source. It is essentially the Examining Attorney's position that TRAVEL BARGAINS is a highly descriptive, laudatory, informational slogan that is commonly used in connection with travel agency services, and thus would not be perceived by purchasers as an indication of source.³

In support of the refusal to register, the Examining Attorney relies upon dictionary definitions; and printouts of portions of 100 stories, from the NEXIS computerized data base of publication information, showing use of the term TRAVEL BARGAIN or TRAVEL BARGAINS.⁴

The dictionary definition evidence, taken from WEBSTER'S II New Riverside University Dictionary (1988), shows that the intransitive verb "travel" is defined as, inter alia, "1. To move from one place to another: JOURNEY."; that the transitive verb form of the word is defined as "To pass over or through <travel the byroads of England>"; that the noun form of the word is defined as,

³ As the Examining Attorney specifically noted in his appeal brief, at footnote 2, page 3, he never raised capability as an issue in any of his Office actions, and it is not an issue in this case.

⁴ The Examining Attorney's NEXIS search found 523 stories containing the term TRAVEL BARGAIN or TRAVEL BARGAINS. The

inter alia, "1. The act or process of traveling."; and that the noun form of the term BARGAIN is defined as, inter alia, "2. Something offered or acquired at a price advantageous to the buyer."

The 100 NEXIS stories made of record by the Examining Attorney include a large number of stories which illustrate the significance of the term TRAVEL BARGAIN or TRAVEL BARGAINS as used in the travel field. Examples of such uses are set forth below (**emphasis** added):

"**TRAVEL BARGAINS**; BOOK TALL SHIP CRUISE BY APRIL, GET DISCOUNT"--headline for story appearing in the February 2, 1997 issue of *The Daily News of Los Angeles* (story #15)⁵

"Personal Passport, a new free CD-ROM, features information on thousands of **travel bargains**, usually 30-40 percent off list price, updated daily via Internet link."--from a story headlined "TRAVEL NOTES" appearing in the January 19, 1997 issue of *The Denver Post*, inter alia (story # 32; also #s 49, 59, 73)

"... my entire Fort Lauderdale-Honolulu-Papeete flight cost was under \$600. I consider it the **travel bargain** of my life."--from a story headlined "REMEMBERING HAWAII" appearing in the January 19, 1997 issue of the *Sun Sentinel* (story # 35)

Examining Attorney submitted the pertinent portions of the first 100 stories.

⁵ There are a number of similar uses in the story excerpts made of record by the Examining Attorney, that is, uses where the designation TRAVEL BARGAINS appears at the beginning of a headline, followed by a semicolon and then other matter which differs in each case. All of these stories were published in *The Daily News of Los Angeles*. It appears that TRAVEL BARGAINS in these cases may be the name of a recurring feature.

"Travelers along the interstates will find that budget motels in the United States are still one of the world's great **travel bargains**."--from a story headlined "WALLET WATCH; Room rates headed up in '97" appearing in the January 12 1997 issue of *The Orange County Register*, inter alia (story # 42; also #s 48, 54, 60-63, 66)

"In Italy, as in the rest of western Europe, the railway is a **travel bargain**. It is timely and inexpensive."--from a story headlined "Independent in Italy; Make your own agenda, and you'll save more" appearing in the January 5, 1997 issue of the *Austin American-Statesman* (story # 47)

"... United States and Europe in some locales for about \$150 a week, weekly rentals are one of the great **travel bargains**. But rental companies have been threatening price hikes for some time ..."--from a story headlined "TRAVEL LETTER'S '97 DEALS" appearing in the January 5, 1997 issue of the *Pittsburgh Post-Gazette* (story # 50)

"Best Fares is a monthly newsletter (published by Parsons) that lists **travel bargains**, including air-fare promotions and coupons."--from a story headlined "If a ticket deal sounds too good to be true, it probably is" appearing in the December 15, 1996 issue of *The News and Observer* (story # 74)

"One recent modification to American Express' Web site is a section, titled Last Minute **Travel Bargains**, that, as its name suggests, offers travel deals on last-minute inventory."--from a story headlined "The Human Element; caring for leisure customers in an electronically-oriented environment; Travel Weekly FOCUS: American Express Travel Related Services" appearing in the December 12, 1996 issue of *Travel Weekly* (story # 77)

"The season for post-holiday air **travel bargains** gained momentum Thursday when

Southwest Airlines initiated a one-week "Winter Freedom Fares" sale ..."--from a story headlined "Southwest starts week of cut-rate winter fares" appearing in the December 6, 1996 issue of the *Arkansas Democrat-Gazette* (story # 80)

"The Cathay deal is one of hundreds of **travel bargains** available to cybersurfers willing to invest a little time. The Web is laden with special airfares, credits for free hotel ..."--from a story headlined "TREKKING THE WEB FOR TRAVEL DEALS" appearing in the December 2, 1996 issue of *Business Week* (story # 84)

"... advantage of advance purchase savings on air fares and other travel expenses can check out the "Last Minute **Travel Bargains**" section on the American Express Travel Web site. The feature lists heavily discounted airline rates, hotel tariffs, ..."--from a story headlined "... WBDC WOMEN'S REPORT; WEB **TRAVEL BARGAINS**; INVESTMENTS UP" appearing in the December 1, 1996 issue of *Crain's Small Business Chicago* (story # 88)

"How to protect yourself? Before accepting any supposed **travel bargain**, ask a series of questions ..."--from a story headlined "WALLET WATCH; Cyberspace; Travel scams on the Net" appearing in the November 17, 1996 issue of *The Orange County Register* (story # 100)

Applicant, in turn, has submitted a substantial amount of evidence in support of its claim that the designation TRAVEL BARGAINS has become distinctive of its travel agency services in commerce.⁶

⁶ In its response filed August 15, 1997, applicant referred to four third-party registrations of marks containing the term BARGAIN or BARGAINS. Submitted with the response were printouts, of unidentified origin, of information concerning the registrations. As noted by the Examining Attorney, in his appeal brief, these third-party registrations were not properly made of

In this regard, applicant has submitted the declaration (with accompanying exhibits) of its president, Bahir Browsh, who declares his belief that TRAVEL BARGAINS has become distinctive of applicant's services through applicant's substantially exclusive and continuous use thereof in interstate commerce for at least five years immediately prior to January 1, 1997 (the date of the declaration).

Additionally, the declaration and exhibits establish certain other facts, recited here. Since 1991, applicant has continuously used the designation TRAVEL BARGAINS, both as a trademark and as a trade name, in connection with discount travel services. Applicant offers discounted airfares, cruises, car rentals, and package tours directly to the public. From 1991 until January 1, 1997, applicant spent more than \$5 million in advertising and promoting its discount travel agency services under the designation TRAVEL BARGAINS. In this effort, applicant has used such

record, because copies of the registrations were not submitted. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). At the same time, if the Examining Attorney had raised this objection in his final action of November 19, 1997, applicant could have cured the deficiency. Because the Examining Attorney failed to object in a timely manner, the objection is deemed waived, and we have considered the registrations in our determination of this case. Nevertheless, these registrations, involving different marks and goods/services, are of no particular value herein, because in situations such as this, each case must be decided on its own record and facts.

media as, inter alia, television (at a cost of roughly \$3 million), radio, newspapers (over 1,200 print ads having appeared in major newspapers throughout the United States, at a cost of \$600,000), mass market periodicals, the Internet, outdoor billboards, and direct mail, as well as weekly fax transmissions, concerning featured trips and fares, sent through the Consolidator's Weekly fax service to approximately 3,500 travel agencies.

Applicant's television promotional activities have included not only short commercials, in which the designation TRAVEL BARGAINS is used prominently in the manner of a service mark (and as a trade name), but also a half-hour travel infotainment series which aired on cable television six days a week, three times a day, for three and one-half years. The show, entitled "The Travel Bargains Show," was first introduced in May of 1991, and was watched by millions of viewers. A total of 294 original episodes were produced. In the samples thereof submitted by applicant on a video tape (Exhibit D), TRAVEL BARGAINS is used as the name of the show, as a service mark, and as a trade name.

Applicant's reservation center receives between 15,000 and 25,000 telephone calls for its services each week; the total number of such phone calls for the 1991-January 1,

1997 period was 5 million. The calls are answered by applicant's telemarketers, who number more than 150, with the words "Thank you for calling TRAVEL BARGAINS." The designation is also used by applicant on ticket jackets, letterhead stationery, and mailing envelopes.

Editorial articles referring to applicant's TRAVEL BARGAINS services have been published in numerous newspapers and magazines, including the *Tampa Sun-Sentinel*, the *New York Post*, and *Men's Health*. In addition, the services are mentioned under the TRAVEL BARGAINS designation in many industry directories and travel guides, including Fielding's Vacation Places Rated, Air Courier Bulletin, The Intrepid Traveler's Guide to Consolidators, Air Travel's Bargain Basement, and Consumer Reports Travel Letter, as well as in Arthur Frommer's Secret Airfares, available through America Online.

During the period between May of 1991 and January 1, 1997, applicant rendered its TRAVEL BARGAINS discount travel services to more than 500,000 customers, and accumulated retail sales of \$140 million. Applicant's surveys indicate that 80% of its sales are from repeat customers or word-of-mouth referrals.

In addition to the declaration and accompanying exhibits, applicant has submitted a printout from an

Internet site entitled "Solutions Central Tip of the Week", for the week of 6/9/97, which features applicant and its services;⁷ letters (written in July 1997) from three individuals in the travel industry concerning recognition of TRAVEL BARGAINS in that industry;⁸ and letters from six

⁷ The text includes such uses as "Call Travel Bargains for quick service and incredible rates when planning your next trip."; "Call 1-800-AIRFARE and, in less than eight minutes, a Travel Bargains consultant will find you the best available airfare rate ..."; "While Travel Bargains won't guarantee that it will always be able to beat the fares offered by the major airlines, it will always match the lowest published airfare out there."; and "... Travel Bargains also offers great deals on car rentals." The site bears a copyright notice in the name of Circle Company Associates.

⁸ A letter from Stanley C. Plog, Ph.D., a market researcher in the travel industry, states that he wrote the book Vacation Places Rated (1995); that in the book, he listed TRAVEL BARGAINS (references to TRAVEL BARGAINS in Mr. Plog's letter appear in capital letters, and with a TM symbol) as a travel consolidator for readers to call; that he considers TRAVEL BARGAINS to be an established name that is well recognized in the marketplace; that the name is distinctive and immediately carries the implication as to the benefits it offers to consumers; and that he also plans to include TRAVEL BARGAINS as a company in his upcoming update of his book, to be called Best and Worst - Stan Plog's Guide to the Best Travel Experiences. Mr. Clark Howard, who has a radio program and a newspaper column relating to travel, states that he "was made known" of TRAVEL BARGAINS (Mr. Howard uses all capital letters in references to TRAVEL BARGAINS) in early 1995; that since then he has followed and reported on the many ways travelers can save with the services of TRAVEL BARGAINS; and that TRAVEL BARGAINS offers a great source of savings for the budget traveler. Mr. Imad Khalidi, President of Auto Europe, a worldwide car, air, and hotel reservation service company, states that Auto Europe has been working closely with Travel Bargains (Mr. Khalidi uses just initial capitals in references to TRAVEL BARGAINS) for the past two years; that Auto Europe's customers are familiar with the products that Travel Bargains supplies and are always pleased to find that they are available through Auto Europe; and that Auto Europe does not hesitate recommending Travel Bargains' services to its business partners, and knows without fail that they will recognize the Travel Bargains' product and name.

customers writing to commend particular employees of applicant for outstanding service.⁹

We turn first to the refusal to register under Section 2(e)(1) of the Act, on the ground that the term TRAVEL BARGAINS, when used in connection with applicant's specified services, is merely descriptive of them, and that the evidence submitted by applicant is insufficient to show that the mark has become distinctive of applicant's services in commerce. We start by noting that a term which is merely descriptive, but not generic, may be registered if secondary meaning is established.¹⁰ This is so even in the case of "highly descriptive" terms. However, the

⁹ Two of these letter writers used "Travel Bargains" only above the salutation, as a trade name along with applicant's address; one used it only in the salutation ("To: Travel Bargains Management"); one used it as a trade name with applicant's address, and also in the text of the letter ("I was a member of TWA Travel Club for two or three years. ... I always get a 'best bet for my money' when I decide to work with Travel Bargain or the Travel Club."); one used it once in the text of the letter ("My story, however, begins back in mid-November when I contacted Travel Bargains to get airfares for a flight to Portland, Oregon ..."); and one, writing on a postcard, used it as a trade name, with applicant's address, and also once in the text ("You are lucky to have her as an employee & I am glad to use Travel Bargains & tell all my friends ...").

¹⁰ The Examining Attorney has never contended that TRAVEL BARGAINS is generic as used in connection with applicant's specified services. Rather, the Examining Attorney's contention is that TRAVEL BARGAINS is highly descriptive of them. Thus, the issue of whether TRAVEL BARGAINS is generic is not before us, and we make no determination of that issue. However, we presume, for purposes of deciding the primary issue before us, namely, the issue of whether applicant's evidence is sufficient to make out a prima showing of secondary meaning, that TRAVEL BARGAINS is not

amount of evidence required to establish a prima facie showing of secondary meaning depends upon the degree of descriptiveness of the term, with more evidence being required for terms which are highly descriptive than for those which are not. As stated by the Court of Appeals for the Federal Circuit (in a discussion of generic and descriptive terms),

A term that is not clearly generic is appropriately viewed as descriptive. Thus the term may acquire trademark status through use. To register such a mark, an adequate showing of acquired distinctiveness or secondary meaning is required. The showing that may be deemed adequate will of course depend on the particular facts; the requisite weight of evidence will vary with the degree of descriptiveness of the mark.

See In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788-1789 (Fed. Cir. 1994).

In the present case, applicant itself has conceded in its appeal brief, for purposes of the appeal, that TRAVEL BARGAINS is merely descriptive. Similarly, in its response filed August 15, 1997, applicant stated, at page 6: "The Nexis search results cited by the Examiner all show the words 'travel bargains' used in their common descriptive sense." Indeed, a careful review of the evidence submitted by applicant reveals that while applicant clearly and

generic as used in connection with applicant's travel agency

consistently uses TRAVEL BARGAINS in the manner of a trademark and trade name in connection with its services, it also, on a few occasions, has itself used the words "in their common descriptive sense," and it appears that such usage has been intentional. For example, a press release dated July 11, 1995, reads in part as follows (**emphasis added**):

TRAVEL BARGAINS, America's premier discount travel service, announces a sizzling summer sale with blisteringly low prices on airline tickets...

Folks who call **TRAVEL BARGAINS** at 1-800-AIRFARE will find exceptionally hot prices to a host of popular summer fun spots...

There's still plenty of time to take off on an exciting, economical **TRAVEL BARGAINS** vacation this summer...

TRAVEL BARGAINS is a leader in providing a full range of travel services -- the affordable way...

So, while others continue to sweat out the high cost of taking a vacation this summer, cost conscious travelers are beating the heat by dialing 1-800-AIRFARE and finding a world of **travel bargains** at their fingertips.

Moreover, in our opinion, the Examining Attorney's evidence amply supports the Examining Attorney's conclusion that TRAVEL BARGAINS is a commonly used term in the travel industry, and that it is not just merely descriptive but highly descriptive of travel agency services which, like

services.

applicant's services, feature discounted airfares, cruises, car rentals, tour packages, etc. In this regard, we particularly note the large number of "hits" found in the NEXIS search, the nature of the uses demonstrated in the examples made of record by the Examining Attorney (namely, the first 100 hits), and the fact that not a single one of the 100 story excerpts made of record appears to be a reference to applicant or its services.¹¹

Because of the highly descriptive nature of the designation TRAVEL BARGAINS as applied to applicant's specified services, applicant's burden in its effort to prove prima facie that the designation has acquired secondary meaning is a heavy one. *See In re K-T Zoe Furniture Inc., supra*, and *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988). We do not believe that the evidence submitted by applicant is sufficient to meet this burden.

While applicant's advertising and resulting sales during the period between May of 1991 and January 1, 1997 have been impressive, there is little in this record to show that the commercial success of applicant's services

¹¹ Applicant itself does not contend that any of the NEXIS excerpts of record is a reference to applicant or its services but rather states, as noted above, that the NEXIS excerpts "all show use of the words 'travel bargains' in their common descriptive sense."

has been accompanied by recognition of the words TRAVEL BARGAINS as a service mark for applicant's services. We note in this regard that there is no consumer survey. Moreover, the references to TRAVEL BARGAINS in the six customer letters and in the trade directories and travel guides appear to stem from applicant's use of TRAVEL BARGAINS as its trade name, rather than from recognition of TRAVEL BARGAINS as a service mark. The three letters from individuals in the travel industry similarly reflect applicant's trade name use, and seem to be more of a testament to the value and quality of applicant's services than to the recognition of TRAVEL BARGAINS as a service mark. Moreover, even if these three letters demonstrated service mark recognition by their authors, who are experienced in the field, they would be insufficient to show service mark recognition on the part of the general public, to whom applicant's services are directed.

In view of the highly descriptive nature of the designation TRAVEL BARGAINS when used in connection with travel agency services featuring discounted rates, and the fact that applicant has the burden of proving distinctiveness, we are not convinced by the evidence submitted by applicant, considered in its totality, that TRAVEL BARGAINS has become distinctive of applicant's

services in commerce. We therefore conclude that the refusal to register based upon Section 2(e)(1) of the Act is well taken.

We turn then to the second ground for refusal, namely, that TRAVEL BARGAINS does not function as a mark. This refusal is duplicative of the first ground for refusal, and does not provide a separate basis for rejection, to the extent that it is based on the descriptive, laudatory, and informative nature of the designation TRAVEL BARGAINS. To the extent that this refusal may be based on a contention that TRAVEL BARGAINS is not used by applicant in the manner of a mark, and thus would not be perceived by customers as such, a review of the specimens and other materials submitted by applicant shows that this is not the case. There is no doubt that TRAVEL BARGAINS is used by applicant in the manner of a mark (often in a design format), as well as in the manner of a trade name and as the name of a television show. Accordingly, this ground for refusal is not well taken.

Decision: The refusal to register under Section 2(e)(1) of the Act on the ground that the asserted mark TRAVEL BARGAINS, when used in connection with applicant's specified services, is merely descriptive of them, and that the evidence submitted by applicant is insufficient to show

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prima facie that TRAVEL BARGAINS has become distinctive of applicant's services in commerce, is affirmed. The refusal to register on the ground that TRAVEL BARGAINS is not used in the manner of, and thus does not function as, a mark is reversed.

J. E. Rice

E. J. Seeherman

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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